

REMARKS

Upon entry of the present amendment, claims 2 and 5 will have been amended while claims 1, 4, 7, and 8 will have been canceled, and new claim 9 is presented for consideration by the Examiner.

In view of the herein contained amendments and remarks, Applicants respectfully request reconsideration and withdrawal of each of the outstanding rejections set forth in the above-mentioned Official Action. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants note with appreciation the Examiner's indication that claims 2, 3, 5, and 6 would be allowable if rewritten in independent form.

Applicants wish to thank the Examiner for acknowledging Applicants Claim for Foreign Priority under 35 U.S.C. § 119 as well as for confirming receipt of the certified copy of the priority document.

Applicants in the present amendment have rewritten claim 5 in independent form in view of the Examiner's objection of the same. Similarly, Applicants have added new claim 9 that includes the subject matter of objected to claim 2 rewritten in independent form to include the subject matter of claim 1. Applicants respectfully assert that claims 5 and 9 are allowable at least in accordance with the Examiner's indication.

The Examiner has rejected claims 1 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent No. 61-197125 to INOUE in view of U.S. Patent 5,676,860 to MURO et al., and has rejected claims 1, 4, 7, and 8, under 35 U.S.C. § 103(a) as being unpatentable over French Patent to BOURREAU in view of MURO et al.

Applicants respectfully traverse the above rejections and submit that they are inappropriate.

With respect to claims 1, 4, 7, and 8, Applicants have canceled these claims without prejudice in order to expedite prosecution in the present application.

With respect to claim 2, the disclosure at page 8, lines 7-24, sets forth using a plate electrode 9 to form a tool electrode 4 (see lines 7-13 and figure 2C). This tool electrode 4 is then subsequently used in electro machining on a workpiece 10 (see lines 20-24 and figure 1) Applicants have amended claim 2 to clarify these distinguishing features of the present invention. In particular, the aspect of the present invention recited in the combination of claim 2 sets forth producing a tool with a plate electrode and also includes part of claim 1 of using the tool to machine a pattern on a workpiece. Because amended claim 2 is a combination of portions claim 1 and portions of claim 2, Applicants respectfully assert that there are no new issues or search needed for amended claim 2.

French Patent No. 2,518,442 to BOURREAU merely discloses a single machining process with spark erosion and vibration. BOURREAU does not disclose producing a tool and then using the tool to form a pattern on a workpiece (See English language abstract).

Similarly, Japanese Patent No. JP 61197125 to INOUE discloses a single machining process of machining a groove with a wire electrode 1 (see English language abstract and figure 1).

In the same manner, U.S. Patent No. 5,676,860 to MURO discloses a single machining process with an electrode 13 on an object 15 (see column 2, lines 58-63).

There is no suggestion or disclosure in BOURREAU al., INOUE or MURO (or in any proper combination thereof) to produce a tool electrode by electro machining with a plate electrode and then to use the tool on a workpiece as recited by amended claim 2. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 103.

In view of the fact that none of the art of record, whether considered alone or in any proper combination, discloses or suggests the present invention as defined by the pending claims, and in further view of the above remarks, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

Pursuant to MPEP §714.13, Applicants contend that entry of the present amendment is appropriate because the proposed amended claims avoid the rejections set forth in the last Office Action, resulting in the application being placed in condition for allowance, or, alternatively, the revised claims place the application in better condition for purposes of appeal. Furthermore, the revised claims do not present any new issues that would require any further consideration and/or search by the Examiner. In particular, amended claim 2 is a combination of portions claim 1 and portions of claim 2. As such, Applicants assert that there are no new issues or search needed. Furthermore, the amendment does not present any additional claims without canceling a like number of pending claims. Accordingly, entry of the present amendment is respectfully requested.

#### SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have amended several of the claims to clarify the recitations thereof. Applicants have submitted two additional claims for consideration by the Examiner.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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